



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,848	09/28/2001	Miles J. Penner	042390P12281	5000

7590 05/02/2005

Todd M. Becker
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

KIM, JUNG W

ART UNIT PAPER NUMBER

2132

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,848

Applicant(s)

PENNER, MILES J.

Examiner

Jung W. Kim

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-28 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims define the limitations "wherein the encrypted data comprises a second code which identifies the device"; however, the specification is enabling only for the limitation "wherein the data comprises second code which identifies the device".

Specification, figure 4, reference nos. 36 and 38

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 7 recites the limitation "the software". There is insufficient antecedent basis for this limitation in the claim. The claim will be interpreted herein to depend on claim 4.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4, 8, 11, 14, 17, 21, 22, 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lewis U.S. Patent No. 5,734,819 (hereinafter Lewis).

9. As per claims 14, 17, 21 and 22, Lewis discloses an apparatus comprising:

a. a device comprising a memory, wherein the memory comprises a non-volatile memory, wherein the non-volatile memory is selected from among a group consisting of EEPROM, EPROM, and flash memory (col. 1:31-37; 3:27-44);

b. a first code stored in the memory, wherein the code uniquely identifies the device (2:51; 5:15-18); and

Art Unit: 2132

- c. an encrypted data set stored in the memory, wherein the data set comprises a second code which identifies the device (2:50; 5:20-26);
- d. software operative with the device
 - i. decrypt the encrypted data set (2:53);
 - ii. compare the first code to the second code (2:56); and
 - iii. load the software into the device if the first code and second codes are identical (3:51-52).

The aforementioned cover the limitations of claims 14, 17, 21 and 22.

10. As per claims 1, 4, 8, 11, 23 and 26, they are claims corresponding to claims 14, 17, 21 and 22 and they do not teach or define above the information claimed in claims 14, 17, 21 and 22. Therefore, claims 1, 4, 8, 11, 23 and 26 are rejected as being anticipated by Lewis for the same reasons set forth in the rejections of claims 14, 17, 21 and 22.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2132

12. Claims 2, 3, 5, 6, 9, 10, 12, 13, 15, 16, 18, 19, 24, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Schneier Applied Cryptography Chapter 2: Protocol Building Blocks (hereinafter Schneier).

13. As per claims 15, 16, 18 and 19, the rejections of claims 14, 17, 21 and 22 under 35 U.S.C. 102(b) are incorporated herein. (supra) In addition, Lewis discloses encrypting the data using a first private encryption key and storing the encrypted data on the device, and decrypting the encrypted data using a first public decryption key. Lewis, 2:49-65. Lewis does not disclose encrypting the once-encrypted data using a second private encryption key prior to storing the encrypted data on the device, and decrypting the twice-encrypted data using a second public decryption key. Schneier discloses twice signing a message, first by the sender of the message using their private key and second by a trusted third party using their private key, whereupon the twice signed message is authenticated by using the public keys of the sender and trusted third party. Schneier, pgs. 40 and 41, "Nonrepudiation and Digital Signatures" and pgs. 37-39, "Signing Documents with Public-key Cryptography", "Signing Documents and Timestamps" and "Signing Documents with Public-key Cryptography and One-Way Hash Functions". It would be obvious to one of ordinary skill in the art at the time the invention was made to twice encrypt the device identifier since it establishes a more secure authentication means, whereby the authentication signature on the device identifier is not compromised if one of the two private keys is uncovered.

Art Unit: 2132

Schneier, pg. 40, "Nonrepudiation and Digital Signatures", 3rd paragraph. The aforementioned cover the limitations of claims 15, 16, 18 and 19.

14. As per claims 2, 3, 5, 6, 9, 10, 12, 13, 24, 25, 27 and 28, they are claims corresponding to claims 15, 16, 18 and 19, and they do not teach or define above the information claimed in claims 15, 16, 18 and 19. Therefore, claims 2, 3, 5, 6, 9, 10, 12, 13, 24, 25, 27 and 28 are rejected as being anticipated by Lewis for the same reasons set forth in the rejections of claims 15, 16, 18 and 19.

15. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Lambeth et al. U.S. Patent No. 6,023,736 (hereinafter Lambeth).

16. As per claim 7, the rejection of claim 1 under 35 U.S.C. 102(b) is incorporated herein. Lewis does not expressly disclose the device as a network adapter and software as a device driver. Lambeth discloses a dynamic configuration process wherein a device driver checks the status of an I/O adapter before continuing with driver configuration on the adapter. Lambeth, col. 9:40-50. It would be obvious to one of ordinary skill in the art at the time the invention was made for the device to be a network adapter and the software to be a device driver since driver configuration of an adapter updates and modifies system configuration, a monitoring methodology on configuration updates ensures that illicit changes to the hardware configuration of the system during

Art Unit: 2132

these configuration updates are not ignored to preserve a manufacturers use agreement. Lewis, 2:65-3:3. The aforementioned cover the limitations of claim 7.

17. As per claim 20, it is a claim corresponding to claim 7, and it does not teach or define above the information claimed in claim 7. Therefore, claim 20 is rejected as being unpatentable over Lewis in view of Lambeth for the same reasons set forth in the rejections of claim 7.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See enclosed PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is (571) 272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

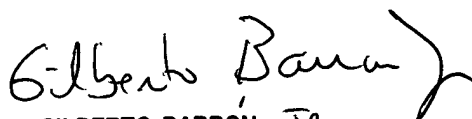
Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim
Examiner
Art Unit 2132

Jk
April 27, 2005



GILBERTO BARRÓN JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100